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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/764,068
Filing Date: January 19, 2001
Appellant(s): EDER, JEFF SCOTT

_____
B.J. Bennett
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 15, 2010 appealing from the Office

action mailed March 31, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

As noted by Appellant, application 10/166,758 and 10/287,586 may be affected or have a bearing on this appeal.

Examiner also notes application 09/940,450 may be affected by or have a bearing on this appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 36-65, 68-69 and 72-75 are pending according to the Appeal Brief filed February 15, 2010. Claims 70 and 71 were canceled in this Appeal Brief dated February 15, 2010. However, they were standing in the Appeal Brief filed August 1, 2009.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) **Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) **Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection is incorrect. For purposes of advancing prosecution, examiner has provided a summary of the grounds of rejection as presented in the Final Office Action:

Claims 64-65 and 67-69 are rejected under 35 U.S.C. 112, first paragraph.

Claims 55-63 and 70-71 are rejected under 35 U.S.C. 112, second paragraph.

Claims 36-45, 55-65 and 67-71 are rejected under 35 U.S.C. 101.

Claims 46, 48 and 53-54 are rejected under 35 U.S.C. 102(b) by Bielinski.

Claims 36-39, 41-43, 45, 55 and 58-63 are rejected under 35 U.S.C. 103(a) by Bielinski and Bauer.

Claim 47 is rejected under 35 U.S.C. 103(a) by Bielinksi.

Claims 72-75 are rejected under 35 U.S.C. 103(a) by Bielinski, Bauer and Lyons.

Claims 64-65 and 67-69 are rejected under 35 U.S.C. 103(a) by Davis and Bielinski.

Claim 70 is rejected under 35 U.S.C. 103(a) by Davis and Srivastava, (listed as canceled as noted above).

Claim 71 is rejected under 35 U.S.C. 103(a) by Davis, Srivastava and Cleland, (listed as canceled as noted above).

Claims 44 and 57 are rejected under 35 U.S.C. 103(a) by Bielinski, Baur and Davis.

Claim 40 is rejected under 35 U.S.C. 103(a) by Bielinski, Baur and Bigus.

Claim 50 is rejected under 35 U.S.C. 103(a) by Bielinski and Stork.

Claims 49 and 51-52 are rejected under 35 U.S.C. 103(a) by Bielinski and Mauboussin.

Claim 56 is rejected under 35 U.S.C. 103(a) by Bielinski, Baur, Mauboussin.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Bigus et al. - US Patent 6,192,354.

Stork et al – US Patent 5,245,696.

Lyons et al. – US Patent 4,989,141.

Davis – US Patent 7,249,328.

Srivastava et al. – US Patent 6,549,922.

Bielinski, Daniel W. – "How to sort out the premium drivers of post-deal value". Mergers and Acquisitions. Philadelphia: Jul/Aug 1993.

Baur, Quintero and Stevens. – "The 1986-88 stock market: investor sentiment or fundamentals?" Managerial and Decision Economics. May/June 1996.

Cleland, A. and Bruno, A. – "Building customer and shareholder value". Strategy & Leadership. Chicago: May/June 1997.

Mauboussin, Michael J. of Credit Suisse First Boston – "Get real: using real options in security analysis". June 23, 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 64-65 and 67-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites new matter with respect to "a physical object or substance". The term is not found within the specification and therefore is improper to use within the claim limitations. Each claim limitation needs to be supported by a particular section in the specification in order to comply with the written description requirement.

Claims 70-71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite new matter with respect to "an integrated database" and with respect to the limitation "output said database". Neither of the terms are found within the specification and therefore are improper to use within the claim limitations. Each claim limitation needs to be supported by a particular section in the specification in order to comply with the written description requirement.

Claims 55-63 and 70-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70 recites "output said database". It is unclear as to what the outputting of a database really means. Based on the 112 first paragraph rejection for failing to comply with the written description requirement, examiner is uncertain as to how the method step of outputting the database would be performed. For purposes of examination, examiner will assume that it is intended to output data from the database.

Claim 55 recites "the identified data". There is insufficient antecedent basis for this limitation in the claim.

Claims 36-45, 55-65, 67-71 are rejected under 35 U.S.C. 101. Based on

Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to

examiners is that a § 101 process must (1) be tied to a machine or (2) transform

underlying subject matter (such as an article or materials) to a different state or thing. In

re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184

(1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S.

63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would <u>not</u> qualify as a statutory process

would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory

process, the claim should positively recite the other statutory class (the thing or product)

to which it is tied, for example by identifying the apparatus that accomplishes the

method steps, or positively recite the subject matter that is being transformed, for

example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit

decision since they are not tied to a machine and can be performed without the use of a

particular machine.

The mere recitation of the machine in the preamble with an absence of a

machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyeret al-

http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2

&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&s

cm=5000&pg=0.

Claims 46, 48 and 53-54 are rejected under 35 U.S.C. 102(b) as being

anticipated by "How to sort out the premium drivers of post-deal value" by Daniel W.

Bielinski (further referred to as Bielinski).

Regarding claim 46, Bielinski discloses a program storage device readable by a

computer, tangibly embodying a program of instructions executable by a computer to

perform an element method (pages 1-7), comprising:

Preparing data representative of an enterprise for use in processing,

transforming at least a portion of the data into a causal model of each of one or more

categories of an organization value (pages 1-7) that identify and output a tangible

contribution of each of one or more elements of value (page 1, section 1; page 2,

sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page

6, sections 1-6) to a current operation and a real option category of value (page 1,

section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6,

sections 4-5), and

reporting the value contribution of the elements of value using an electronic

display or a paper document (page 1, section 1; page 3, section 10; page 4, sections 4

and 6-7).

Regarding claim 48, Bielinski discloses where a tangible value contribution for

each of one or more elements of value to each of one or more categories of value

further comprises a direct element contribution to a category of value net of any element

of value impacts on other elements of value (page 1, section 2; page 2, section 1; page

3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page 6, sections 5-6).

Regarding claim 53, Bielinski discloses where the calculated value for each

element of value further comprises a value for a point in time within a sequential series

of points in time (page 1, section 1; page 2, section 1; page 6, section 5).

Regarding claim 54, Bielinksi discloses wherein the net relative contribution for

each element of value to each category of value further comprises a net causal

contribution (page 1, section 2; page 2, section 1; page 3, sections 7-9; page 4, sections

1-4, 7; page 5, section 1; page 6, sections 5-6).

Claims 36-39, 41-43, 45, 55 and 58-63 is rejected under 35 U.S.C. 103(a) as

being unpatentable over "How to sort out the premium drivers of post-deal value" by

Daniel W. Bielinski (further referred to as Bielinski), and further in view of "The 1986-88

stock market: investor sentiment or fundamentals?" by Baur, Quintero and Stevens

(further referred to as Baur).

Regarding claim 36, Bielinski discloses a computer implemented enterprise

method (pages 1-7), comprising:

Preparing data representative of an enterprise for use in processing, and transforming at least a portion of the data into a model of an enterprise market value by an element and category of value by completing a series of multivariate analyses that utilizes said data (pages 1-7),

Where the categories of value are selected from the group consisting of current operation, real option and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Where the model of enterprise market value identifies and outputs a tangible contribution of each element of value to each category of value (page 1, section 1; page 2, sections 1 and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6).

Bielinski does not disclose where the elements of value are selected from the group consisting of alliances, brands, channels, customers, employees, intellectual property, partnerships, processes, vendors and combinations thereof. However, Bielinksi does disclose where the elements of value are selected from alliances, employees, partnerships, processes and vendors (page 3, sections 1-5; page 4, sections 4-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further elements of value as are known to be a part of a group in the art.

Bielinski does not disclose where a category of value is market sentiment. However, Baur discloses where a category of value is market sentiment (abstract; page

2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one

of ordinary skill in the art at the time of the invention to modify the valuation modeling

techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and

pricing/value factor as disclosed by Baur. The motivation would be that stock price is

calculated based on company value and a company value is derived from real and

intangible assets of value and for most accurate pricing, one would want to incorporate

all assets, real and intangible.

Regarding claim 37, Bielinski does not disclose completing activities from the

group consisting of the full list of activities as cited. However, Bieliski discloses

completing activities from the group such as: completing an analysis of enterprise

financial performance, optimizing one or more aspects of enterprise financial

performance, simulating an enterprise financial performance, optimizing a future

enterprise market value, quantifying a future enterprise market value, creating a

management report valuing a real option, and combinations thereof (pages 1-5). It is

noted that the claim is set forth as a Markush claim and as such each of the items within

the set are admittedly within a group known in the art. Therefore it would be obvious to

provide further completion of activities as are known to be a part of a group in the art.

Regarding claim 38, Bielinski discloses identifying one or more changes that will

optimize one or more aspects of financial performance (pages 1-7). Bielinski does not

disclose where the aspects of financial performance are selected from the group

consisting of revenue, expense, capital change, cash flow, real option value, future

market value, market sentiment value, market value and combinations thereof.

However, Bielinski discloses where aspects of financial performance are selected from

the group such as: revenue, expense, cash flow, real option value, future market value,

market value and combinations thereof (pages 1-7). It is noted that the claim is set forth

as a Markush claim and as such each of the items within the set are admittedly within a

group known in the art. Therefore it would be obvious to provide further aspects of

financial performance as are known to be a part of a group in the art.

     Regarding claim 39, Bielinski does not disclose where a series of multivariate

analyses are selected from the group consisting of the full list as cited in the claim.

However, Bielinski discloses where a series of multivariate analyses are selected from

the group such as identifying one or more previously unknown relationships between

one or more value drivers, identifying one or more previously unknown relationships

between one or more elements of value, quantifying one or more inter-relationships

between value drivers, quantifying one or more impacts between elements of value,

determining a net impact for each category of value, calculating one or more real option

values, and combinations thereof (pages 1-7). It is noted that the claim is set forth as a

Markush claim and as such each of the items within the set are admittedly within a

group known in the art. Therefore it would be obvious to provide further multivariate

analyses as are known to be a part of a group in the art.

Regarding claim 41, Bielinksi does not disclose wherein data representative of an enterprise are obtained from systems selected from the group consisting of the full list as cited in the claim. However, Bielinski discloses wherein data representative of an enterprise are obtained from systems selected from the group such as advanced financial systems, basic financial systems, process management systems, supply chain management systems, vendor management systems, operation management systems, sales management systems, human resource systems, accounts receivable systems, accounts payable systems, inventory systems, and combinations thereof (pages 1-7). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further enterprise transaction data as are known to be a part of a group in the art.

Regarding claim 42, Bielinski discloses using one or more composite applications to complete the processing (page 1, section 1; page 2, section 1; page 3, sections 8-9; page 7, section 6).

Regarding claim 43, Bielinski does not disclose a combination of component and category of value models selected from the group consisting of up to three predictive component value models, a real option discount rate model, a real option valuation model, a market sentiment model by element of value and combinations thereof. Bielisnki discloses a combination of component and category of value models selected

from the group consisting of up to three predictive component value models, a real

option valuation model, and combinations thereof (pages 1-7). It is noted that the claim

is set forth as a Markush claim and as such each of the items within the set are

admittedly within a group known in the art. Therefore it would be obvious to provide

further models as are known to be a part of a group in the art.

Regarding claim 45, Bielinski discloses identifying one or more changes that will

optimize a future market value portion of said enterprise market value (pages 1-7).

Regarding claim 55, Bielinski discloses a computer implemented future market

value method (pages 1-7), comprising:

Preparing data representative of an organization for use in processing,

transforming at least a portion of the data into a causal model of each of one or more

categories of an organization value (pages 1-7), that calculate and output a tangible

value contribution of each of one or more elements of value to a future market value

and each of the categories of organization value (page 1, section 1; page 2, sections 1

and 7; page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6,

sections 1-6)

Where the categories of value comprise a current operation and a real option

category and combinations thereof (page 1, section 2; page 2, section 7; page 3,

sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Bielinski does not disclose where the elements of value are selected from the group consisting of alliances, brands, channels, customers, customer relationships, employees, intellectual property, partnerships, processes, vendors and combinations thereof. However, Bielinksi does disclose where the elements of value are selected from alliances, employees, partnerships, processes, vendors and vendor relationships (page 3, sections 1-5; page 4, sections 4-6). It is noted that the claim is set forth as a Markush claim and as such each of the items within the set are admittedly within a group known in the art. Therefore it would be obvious to provide further elements of value as are known to be a part of a group in the art.

Bielinski does not disclose where a category of value is market sentiment. However, Baur discloses where a category of value is market sentiment (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and pricing/value factor as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.

Regarding claim 58, Bielinski discloses where a net relative contribution for each of one or more elements of value to each of one or more categories of value further comprises a direct element contribution to a category of value net of any element

impacts on other elements of value within said category of value (page 1, section 2;

page 2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page

6, sections 5-6).

Regarding claim 59, Bielinski does not disclose a plurality of models selected

from the group consisting of predictive component of value models, predictive market

value models, relative element strength models, real option discount rate models, real

option valuation models, market sentiment models and combinations thereof. Bielisnki

discloses a plurality of models selected from the group consisting of predictive

component of value models, predictive market value models, relative element strength

models, real option valuation models, and combinations thereof (pages 1-7). It is noted

that the claim is set forth as a Markush claim and as such each of the items within the

set are admittedly within a group known in the art. Therefore it would be obvious to

provide further models as are known to be a part of a group in the art.

Regarding claim 60, Bielinski discloses where a net contribution for each of one

or more elements of value further comprises a direct contribution to a value of a

category of value net of any impact on other elements of value (page 1, section 2; page

2, section 1; page 3, sections 7-9; page 4, sections 1-4, 7; page 5, section 1; page 6,

sections 5-6).

Regarding claim 61, Bielinski discloses where one or more categories of value are selected from the group consisting of current operation, real option and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5). Bielinski does not disclose where a category of value is market sentiment. However, Baur discloses where a category of value is market sentiment (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver as disclosed by Baur. The motivation would be that stock price is calculated based on company value and a company value is derived from real and intangible assets of value and for most accurate pricing, one would want to incorporate all assets, real and intangible.

Regarding claim 62, Bielinski discloses where the future market value portion of organization market value comprises a summation of values selected from current operation value, real option value and combinations thereof (page 1, section 2; page 2, section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5). Bielinski does not disclose market sentiment value. However, Baur discloses market sentiment in valuation (abstract; page 2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation modeling techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver as disclosed by Baur. The motivation would be that stock

price is calculated based on company value and a company value is derived from real

and intangible assets of value and for most accurate pricing, one would want to

incorporate all assets, real and intangible.

Regarding claim 63, Bielinski does not disclose where the value driver changes

that will optimize future market value are identified by algorithms selected from the

group consisting of monte carlo algorithms, genetic algorithms, multi criteria

optimization algorithms and combinations thereof. However, Bielinski discloses where

the value driver changes that will optimize future market value are identified by multi

criteria optimization algorithms (page 2, section 1; page 3, sections 7-9; page 4, section

7; page 5, section 1; page 6, sections 5-6). It is noted that the claim is set forth as a

Markush claim and as such each of the items within the set are admittedly within a

group known in the art. Therefore it would be obvious to provide further algorithms as

are known to be a part of a group in the art.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski.

Regarding claim 47, Bielinski does not disclose where the elements of value are

selected from the group consisting of alliances, brands, channels, customers, customer

relationships, employees, intellectual property, partnerships, processes, production

equipment, vendors and vendor relationships and combinations thereof. However,

Bielinksi does disclose where the elements of value are selected from alliances,

employees, partnerships, processes, production equipment, vendors and vendor

relationships (page 3, sections 1-5; page 4, sections 4-6). It is noted that the claim is

set forth as a Markush claim and as such each of the items within the set are admittedly

within a group known in the art. Therefore it would be obvious to provide further

elements of value as are known to be a part of a group in the art.

        Claims 72-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over

"How to sort out the premium drivers of post-deal value" by Daniel W. Bielinski (further

referred to as Bielinski), in view of "The 1986-88 stock market: investor sentiment or

fundamentals?" by Baur, Quintero and Stevens (further referred to as Baur), and further

in view of US Patent 4,989,141 to Lyons et al. (further referred to as Lyons).

        Regarding claim 72, Bielinski discloses An organization system comprising of a

computer with a processor having circuitry to execute instructions, a storage device

available to said processor with sequences of instructions stored therein, which when

executed cause the processor to complete a computer implemented market value

accounting method (pages 1-7), comprising:

        Preparing a plurality of data representative of an organization for use in

processing, transforming at least a portion of the data into a model each of one or more

categories of an organization value (pages 1-7), that identify and output a tangible

contribution of each of one or more elements of value to the categories of organization

value by completing a series of analyses (page 1, section 1; page 2, sections 1 and 7;

page 3, sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6)

Where the categories of value further comprise a current operation category of

value and a real option category and combinations thereof (page 1, section 2; page 2,

section 7; page 3, sections 1-6 and 9; page 4, section 3; page 6, sections 4-5),

Using the tangible contribution for each element of value to identify a market

value for each element of value (page 1, section 1; page 2, sections 1 and 7; page 3,

sections 1-9; page 4, sections 1-7; page 5, sections 1-7; page 6, sections 1-6), and

Reporting the value of each element of value (page 1, section 1; page 3, section

10; page 4, sections 4 and 6-7).

Bielinski does not disclose where a category of value is market sentiment.

However, Baur discloses where a category of value is market sentiment (abstract; page

2, "Stock prices and investor sentiment"; page 3, formula 3). It would be obvious to one

of ordinary skill in the art at the time of the invention to modify the valuation modeling

techniques as disclosed by Bielinski to adapt the use of sentiment as a value driver and

to calculate stock price using sentiment as disclosed by Baur. The motivation would be

that stock price is calculated based on company value and a company value is derived

from real and intangible assets of value and for most accurate pricing, one would want

to incorporate all assets, real and intangible.

Neither Bielinski nor Baur disclose reporting in a balance sheet format and where

the reported value is a value for a specific point in time within a sequential series of

points in time. However, Lyons discloses reporting in a balance sheet format (column 2,

lines 16-34; column 3, lines 1-10; column 10, lines 1-9; column 16, lines 61-68; column 24, line 50 – column 25, line 12 where it is disclosed that users input data from various reports such as balance sheets and income statements, the data can be manipulated and analyzed across departments in an organization, for example, and then a report can be generated representing data as requested by a user and wherein it would be obvious that if data is submitted in the form of a balance sheet or income statement, that data could then be output in the same format) and where the reported value is a value for a specific point in time within a sequential series of points in time (column 2, lines 61-66; column 8, lines 56-61). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the data analysis of key drivers of market value as disclosed by Bielinski and Baur to adapt the use of providing reports in balance sheet format and providing values for a specific point in time across a sequential period of time as disclosed by Lyons. The motivation would be that a balance statement provides key data in understanding market value of an enterprise, and further value is analyzed and understood at certain points in time relative to a continuum of time.

Regarding claim 73, neither Bielinski nor Baur disclose including a value for one or more financial assets in a report with a balance sheet format. However, Lyons discloses including a value for a plurality of financial assets in a report with a balance sheet format (column 2, lines 16-34; column 3, lines 1-10; column 10, lines 1-9; column 16, lines 61-68; column 24, line 50 – column 25, line 12) where it is disclosed that users input data from various reports such as balance sheets and income statements, the

data can be manipulated and analyzed across departments in an organization, for

example, and then a report can be generated representing data as requested by a user

and wherein it would be obvious that if data is submitted in the form of a balance sheet

or income statement, that data could then be output in the same format. Given the

combination of Bielinski, Baur and Lyons as cited in claim 72 with regards to presenting

data in a balance sheet format, it is further obvious to report multiple values in a balance

sheet format as balance sheets contain various types of data.

　　　　Regarding claim 74, neither Bielinski nor Baur specifically disclose tracking a

change in value of each of one or more elements of value over time, and including the

calculated changes in value of each element of value in an income statement or a cash

flow statement. However, Lyons discloses tracking a change in value of each of one or

more elements of value over time (column 2, lines 58-66; column 8, lines 56-61), and

including the calculated changes in value of each element of value in an income

statement or a cash flow statement (column 2, lines 16-34; column 3, lines 1-10; column

10, lines 1-9; column 16, lines 61-68; column 24, line 50 – column 25, line 12) where it

is disclosed that users input data from various reports such as balance sheets and

income statements, the data can be manipulated and analyzed across departments in

an organization, for example, and then a report can be generated representing data as

requested by a user and wherein it would be obvious that if data is submitted in the form

of a balance sheet or income statement, that data could then be output in the same

format. Given the combination of Bielinski, Baur and Lyons as cited in claim 72 with

regards to presenting data in a balance sheet format, it is further obvious to report

values over a period of time in traditional financial forms such as an income statement

or cash flow statement format.

Regarding claim 75, Bielinski does not disclose where the elements of value are

customers and elements of value selected from the group consisting of alliances,

brands, channels, employees, intellectual property, partnerships, processes, vendors

and vendor relationships and combinations thereof. However, Bielinksi does disclose

where the elements of value are selected from alliances, employees, partnerships,

processes, vendors and vendor relationships (page 3, sections 1-5; page 4, sections 4-

6). It is noted that the claim is set forth as a Markush claim and as such each of the

items within the set are admittedly within a group known in the art. Therefore it would

be obvious to provide further elements of value as are known to be a part of a group in

the art.

Claim 64-65 and 67-69 are rejected under 35 U.S.C. 103(a) as being

unpatentable over US Patent 7,249,328 B1 to Davis (further referred to as Davis), and

further in view of "How to sort out the premium drivers of post-deal value" by Daniel W.

Bielinski (further referred to as Bielinski).

Regarding claim 64, Davis discloses a composite application method for data

processing, comprising:

Using two or more independent components of application software to produce

one or more useful results (column 8, lines 23-51; column 9, lines 1-11; column 12, lines

11-56; column 36, lines 59-67; column 37, lines 5-8; column 38, lines 48-56);

by transforming data representative of a physical object or substance with a utility

in managing or monitoring a real world activity of said object or substance (column 8,

lines 23-51; column 9, lines 1-11; column 12, lines 26-56; column 37, lines 5-8; column

38, lines 48-56).

where data has been aggregated from two or more systems (column 8, lines 29-

34; column 10, lines 25-26; column 11, lines 24-27; column 12, lines 26-29 and lines 53-

56; column 28, lines 31-34; column 38, lines 50-53)

in accordance with a common model or schema defined by an xml metadata

standard (column 8, lines 40-46 and lines 52-57; column 10, lines 31-33 and lines 52-

55; column 11, lines 24-66; column 12, lines 45-56; column 13, lines 34-37; column 15,

lines 60-67; column 18, lines 48-54; column 26, lines 65-67; column 27, lines 1-5;

column 28, lines 31-34; column 30, lines 42-50; column 30, lines 51-60; column 33,

lines 15-47; column 37, lines 5-8; column 38, lines 48-56).

Davis does not disclose where data is transformed into a predictive model.

However, Bielinski discloses where data is transformed into a predictive model (page 1,

section 1; page 2, section 1; page 4, section 2; page 6, section 2). It would be obvious

to one of ordinary skill in the art to modify the use of graphing and charting of data

received from multiple sources for the purpose of tracking how organizations are

performing, for example, as disclosed by Davis to adapt the use of predictive models as

disclosed by Bielinski. The motivation would be that as historic and current data is

obtained and useful for understanding what has occurred in the far or recent past,

businesses are always looking forward and attempting to quantify and understand how

the future value of a company can be maximized, as disclosed by Bielinski, where this

analysis includes both past-, present- and future-looking data.

     Regarding claim 65, Davis discloses where the independent components of

application software can be flexibly combined as required to support the development of

one or more useful results (column 8, lines 23-51; column 9, lines 1-11; column 12, lines

11-56; column 36, lines 59-67; column 37, lines 5-8; column 38, lines 48-56).

     Regarding claim 67, Davis does not disclose where the independent components

of application software complete processing selected from the group consisting of the

full list as stated in the claim limitation. However, Davis discloses where the

independent components of application software complete processing selected from the

group such as: analysis, attribute derivation, classification, clustering, data acquisition,

data conversion, data storage, data transformation, keyword match identification, and

combinations there of (column 4, lines 10-45; column 8, lines 24-46; column 8, line 65 –

column 9, line 5; column 9, lines 59-67; column 10, lines 19-53; column 11, lines 24-64;

column 12, lines 15-56; column 13, lines 20-48; column 15, lines 60-67; column 16,

lines 11-15; column 17, lines 7-12 and lines 38-67; column 18, lines 1-67; column 20,

lines 32-38; column 21, lines 26-59; column 23, lines 64-67; column 26, lines 47-67;

column 27, lines 1-21; column 28, lines 31-39; column 30, lines 51-58; column 31, lines

33-50; column 33, lines 28-47; column 36, lines 59-67; column 37, lines 5-8; column 38,

lines 48-65; column 45, lines 1-14; column 49, lines 19-48; column 50, lines 38-49). It is

noted that the claim is set forth as a Markush claim and as such each of the items within

the set are admittedly within a group known in the art. Therefore it would be obvious to

provide further processes as are known to be a part of a group in the art.

Regarding claim 68, Davis does not disclose where the useful results are

selected from the group consisting of the full list as stated in the claim limitation.

However, Davis discloses where the useful results are selected from the group such as:

enterprise financial performance analysis, management reporting, share price valuation,

sub-element clustering and combinations thereof (column 8, lines 36-51; column 9, lines

59-67; column 10, lines 31-53; column 11, lines 52-62; column 12, lines 26-56; column

45, lines 1-14 and lines 40-50; column 49, lines 20-42). It is noted that the claim is set

forth as a Markush claim and as such each of the items within the set are admittedly

within a group known in the art. Therefore it would be obvious to provide further useful

results as are known to be a part of a group in the art.

Regarding claim 69, Davis does not disclose where two or more systems are

selected from the group consisting of the full list as stated in the claim limitation.

However, Davis discloses where the enterprise management systems are selected from

the group such as: accounts receivable systems, accounts payable systems, advanced

financial systems, basic financial systems, process management systems, operation

management systems, sales management systems, capital asset systems, inventory

systems, the Internet, external databases and combinations thereof (column 8, lines 24-

51; column 9, lines 59-67; column 10, lines 31-53; column 11, lines 52-62; column 12,

lines 26-56; column 45, lines 1-14 and lines 40-50; column 49, lines 20-42). It is noted

that the claim is set forth as a Markush claim and as such each of the items within the

set are admittedly within a group known in the art. Therefore it would be obvious to

provide further systems as are known to be a part of a group in the art.

        Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis,

and further in view of US Patent 6,549,922 B1 to Srivastava et al. (further referred to as

Srivastava).

        Regarding claim 70, Davis discloses a computer implemented data processing

method, comprising:

        Integrating, converting and storing data representative of an organization from a

plurality of disparate sources (column 8, lines 29-34; column 10, lines 25-26; column 11,

lines 24-27; column 12, lines 26-29 and lines 53-56; column 28, lines 31-34; column 38,

lines 50-53) in accordance with a common xml schema (column 8, lines 40-46 and lines

52-57; column 10, lines 31-33 and lines 52-55; column 11, lines 24-66; column 12, lines

45-56; column 13, lines 34-37; column 15, lines 60-67; column 18, lines 48-54; column

26, lines 65-67; column 27, lines 1-5; column 28, lines 31-34; column 30, lines 42-50;

column 30, lines 51-60; column 33, lines 15-47; column 37, lines 5-8; column 38, lines

48-56) to transform said data into an integrated database and output said [database –

data per 112] (column 11, lines 15-64; column 12, lines 45-56; column 13, lines 18-40;

column 15, lines 23-42; column 16, lines 11-15; column 26, lines 47-67; column 49,

lines 20-28)

Where metadata mapping is guided by a metadata mapping table (column 10,

lines 19-53; column 11, lines 24-64; column 12, lines 45-56; column 15, lines 60-67;

column 18, lines 2-14; column 20, lines 32-38; column 21, lines 26-61; column 30, lines

51-58; column 33, lines 28-47; column 49, lines 19-47; column 50, lines 38-45);

Davis does not disclose where a metadata and conversion rules window is used

to establish a metadata mapping table. However, Srivastava discloses where a

metadata and conversion rules window is used to establish a metadata mapping table

(Figure 2; column 3, lines 27-62; column 5, lines 14-18; column 6, lines 15-18; column

7, lines 27-31). It would be obvious to one of ordinary skill in the art at the time of the

invention to modify the use of metadata mapping tables as disclosed by Davis to

provide a window for establishing the tables as disclose by Srivastava. The motivation

is that GUIs use windows for providing a user interface for such functions as defining a

metadata table and it would be obvious to use a commonly known technique for

establishing tables, namely the providing of a window, as disclosed by Srivastava.

Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis

and Srivastava as applied to claim 70 above, and further in view of "Building customer

and shareholder value" by A. Cleland and A. Bruno (further referred to as Cleland).

Regarding claim 71, Davis discloses where each of one or more tables in an

application database further comprise one axis that is defined by one or more time

periods that require data (Figure 14A-F, 15B-C, 16-17, 20A-D, 22A-B).

Neither Davis nor Srivastava disclose another axis that is defined by one or more

data categories selected from the group consisting of components of value, sub-

components of value, known value drivers, elements of value, non-relevant attributes

and combinations thereof. However, Cleland discloses another axis that is defined by

one or more data categories selected from the group such as components and

elements of value and known value drivers (Exhibits 1-5 and related text). It would be

obvious to one of ordinary skill in the art at the time of the invention to modify the use of

analysis and charting of key financial figures using metadata as disclosed by Davis and

Srivastava to adopt the charting of value as disclosed by Cleland. The motivation would

be that charts provide a visual representation of data which is often more meaningful

than the raw data itself for drawing conclusions about the data, such as if one were

reviewing data related to customer and/or stockholder value as disclosed by Cleland. It

is further noted that the claim is set forth as a Markush claim and as such each of the

items within the set are admittedly within a group known in the art. Therefore it would

be obvious to provide further processes as are known to be a part of a group in the art.

Claims 44 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable
over Bielinski and Baur as applied to claims 36 and 55 above, and further in view of
Davis.

Regarding claim 44, neither Bielinksi nor Baur disclose where preparing
transaction data for use in processing further comprises integrating said data in
accordance with a common schema where the common schema is defined by a
COBRA metadata or an xml metadata. However, Davis discloses where preparing
transaction data for use in processing further comprises integrating said data in
accordance with a common schema where the common schema is defined by a
COBRA metadata or an xml metadata (column 8, lines 40-46 and lines 52-57; column
10, lines 31-33 and lines 52-55; column 11, lines 24-66; column 12, lines 45-56; column
13, lines 34-37; column 15, lines 60-67; column 18, lines 48-54; column 26, lines 65-67;
column 27, lines 1-5; column 28, lines 31-34; column 30, lines 42-50; column 30, lines
51-60; column 33, lines 15-47; column 37, lines 5-8; column 38, lines 48-56) to support
organization processing (column 8, lines 29-34 and lines 40-51; column 9, lines 1-6;
column 10, lines 19-30; column 12, lines 15-17; column 13, lines 19-23; column 25,
lines 53-60; column 26, lines 47-67; column 28, lines 31-40; column 36, lines 59-67;
column 37, lines 5-12; column 38, lines 48-65). It would be obvious to one of ordinary
skill in the art at the time of the invention to modify the data analysis for value drivers as
disclosed by Bielinksi and Baur to adapt the use of integrating data using xml metadata

as disclosed by Davis. The motivation would be that to understand the overall value of

an enterprise, it would be advantageous to gather data from various groups and

departments and providing a common schema for doing so creates a more efficient

means of sharing data, as disclosed by Davis.

Regarding claim 57, neither Bielinski nor Baur disclose the use of a flexible

system architecture where said architecture further comprises event data that has been

integrated in accordance with a common xml schema and independent components of

application software that can be combined to process said data as required to produce

useful results. However, Davis discloses the use of a flexible system architecture where

said architecture further comprises event data that has been integrated in accordance

with a common xml schema and independent components of application software that

can be combined to process said data as required to produce useful results (column 8,

lines 40-46 and lines 52-57; column 10, lines 31-33 and lines 52-55; column 11, lines

24-66; column 12, lines 45-56; column 13, lines 34-37; column 15, lines 60-67; column

18, lines 48-54; column 26, lines 65-67; column 27, lines 1-5; column 28, lines 31-34;

column 30, lines 42-50; column 30, lines 51-60; column 33, lines 15-47; column 37,

lines 5-8; column 38, lines 48-56) It would be obvious to one of ordinary skill in the art

at the time of the invention to modify the data analysis for value drivers as disclosed by

Bielinksi and Baur to adapt the use of integrating data using xml metadata as disclosed

by Davis. The motivation would be that to understand the overall value of an enterprise,

it would be advantageous to gather data from various groups and departments and

providing a common schema for doing so creates a more efficient means of sharing

data, as disclosed by Davis.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski

and Baur as applied to claim 39 above, and further in view of US Patent 6,192,354 B1

to Bigus et al. (further referred to as Bigus).

Regarding claim 40, neither Bielisnki nor Baur disclose wherein a predictive

model algorithm is selected from the group consisting of neural network; classification

and regression tree; generalized autoregressive conditional heteroskedasticity;

regression; generalized additive; redundant regression network; rough-set analysis;

Bayesian; multivariate adaptive regression spline and support vector method. However,

Bigus discloses wherein a selected predictive model algorithm is Bayesian (column 12,

lines 40-65; column 12, lines 28-33). It would be obvious to one of ordinary skill in the

art at the time of the invention to modify the use of optimization using predictive models

as disclosed by Bielinksi and Baur to adapt the optimization of tasks using a Bayesian

predictive algorithm as disclosed by Bigus. The motivation would be to use a well

known algorithm which enables machine learning in order to improve the predictive

results.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski

as applied to claim 46 above, and further in view of US Patent 5,245,696 to Stork et al.

(further referred to as Stork).

Regarding claim 50, Bielinski does not disclose where the element of value

contributions are identified by learning from the data However, Stork discloses learning

from data. It would be obvious to one of ordinary skill in the art at the time of the

invention to modify the predictive modeling for optimization as disclosed by the Bielinksi

to adapt the use of learning from the data, such as through genetic algorithms, as

disclosed by Stork. The motivation would be to provide a means by which the modeling

would continue to make better optimizations based on data and feedback.

Claims 49 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Bielinski as applied to claim 46 above, and further in view of "Get Real: using real

options in security analysis" by Michael J. Mauboussin of Credit Suisse First Boston

(further referred to as Mauboussin).

Regarding claims 49 and 51, Bielinksi discloses identifying one or more elements

of value that make a casual contribution to an organization market value (pages 1-7).

Bielinski does not disclose computing a difference between a real option value

calculated using the company cost of capital as the discount rate and a value calculated

using a real option discount rate comprised of a base discount rate plus a risk factor for

each element of value that makes a causal contribution to organization market value;
and assigning the value difference to the different elements of value based on their
relative contribution to a calculated difference in the two discount rates. However,
Mauboussin discloses calculating the difference between real option value using current
equity value and discounted cash flow analysis (page 3, section 8; page 15, sections 1-
2 and 6) in order to capture the value of real options (page 4, section 1; page 13,
section 5) where an evaluation of risk and the difference in value when including real
options is allocated to an investment potential (page 5, sections 4-6; page 15, sections
2 and 6) such that an understanding between disparities between discounted cash flows
and stock prices can be understood (page 8, section 3; page 13). It would be obvious
to one of ordinary skill in the art at the time of the invention to modify the valuation of
real options as disclosed by Bielinski to adapt the computational techniques as
disclosed by Mauboussin. The motivation would be to use mathematical techniques
which have been determined to best capture the value of real options as an enterprise
considers their overall value and conducts stock price analysis.

     Regarding claim 52, Bielsinki discloses identifying one or more value drivers for
each element of value (pages 1-7), developing one or more element impact summaries
from said value drivers for market value and each component of value (page 1, sections
1-2; page 2, sections 1 and 7; page 3, sections 7-9; page 4, sections 1-4 and 7),
identifying a best fit combination of element impact summaries and predictive model
algorithm for modeling market value and each component of value (page 2, section 1;

page 3, sections 7-9; page 4, sections 4 and 7; page 5, section 1; page 6, section 5-6),

determining a relative strength for each of the elements of value change vis a vis

competitors (page 2, section 1; page 3, sections 7-9; page 4, sections 4 and 6-7),

calculating a real option value, identifying a net element contribution to enterprise

market value by category of value by combining the results from the processing of steps

above (page 3, sections 7-9; page 4, sections 6-7; page 5, section 1; page 6, sections

3-6). Bielinski does not disclose calculating a real option discount rate and calculating

the real option value using the discount rate. However, Mauboussin discloses

calculating a real option discount rate and calculating the real option value using the

discount rate (page 4, section 1; page 5, sections 4-6; page 8, section 3; page 15,

sections 1-2 and 6). It would be obvious to one of ordinary skill in the art at the time of

the invention to modify the valuation of real options as disclosed by Bielinski to adapt

the computational techniques as disclosed by Mauboussin. The motivation would be to

use mathematical techniques which have been determined to best capture the value of

real options as an enterprise considers their overall value and conducts stock price

analysis.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bielinski

and Baur as applied to claim 55 above, and further in view of "Get Real: using real

options in security analysis" by Michael J. Mauboussin of Credit Suisse First Boston

(further referred to as Mauboussin).

Regarding claim 56, Bielinksi discloses identifying one or more elements of value that make a casual contribution to an organization market value (pages 1-7).

Neither Bielinski nor Baur disclose wherein the discount rate for a real option valuation comprises a base discount rate plus a risk factor for each element of value that is causal to organization market value. However, Mauboussin discloses calculating the difference between real option value using current equity value and discounted cash flow analysis (page 3, section 8; page 15, sections 1-2 and 6) in order to capture the value of real options (page 4, section 1; page 13, section 5) where an evaluation of risk and the difference in value when including real options is allocated to an investment potential (page 5, sections 4-6; page 15, sections 2 and 6) such that an understanding between disparities between discounted cash flows and stock prices can be understood (page 8, section 3; page 13). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the valuation of real options as disclosed by Bielinski and Baur to adapt the computational techniques as disclosed by Mauboussin. The motivation would be to use mathematical techniques which have been determined to best capture the value of real options as an enterprise considers their overall value and conducts stock price analysis.

(10) Response to Argument

Appellant speaks to a number of supposed errors in the rejection of the claims in the present application. Examiner respectfully disagrees with the arguments and finds

that the prior art references as applied in the Final Office Action are proper, pertinent, and relevant in disclosing the claims as submitted.

Appellant argues that the prior art references teach away from the claimed invention. Examiner respectfully disagrees and does not find any instances where the prior art cited teaches away from the claims as presented in the present application. None of the prior art references relied upon in anyway discredit or criticize the claims as presented in this application. It is stated that "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Appellant has argued that the cited references fail to teach or suggest one or more limitations of the claims. However, examiner contends that each limitation has been addressed by a proper reference and through proper combinations. Every limitation has been addressed in the Office Action, with each claim limitation mapped, and every word of the claim taken into consideration. Due to the lengthy rejection presented above, the claims and their respective mapping will not be reiterated here. However, examiner contends that a thorough review and mapping of the claims has been conducted in accordance with procedures of claim interpretation and analysis.

Appellant argues that the combination of references would not provide for functionality as described. However, examiner notes that the arguments presented are outside the scope of the claims and that as presented, the references are proper

combinations yielding predictable results. The elements for which the references were relied upon, based on the analogous art as described above, would properly be combined with functionality as disclosed. For example, Bielinksi discloses the use of modeling for representing organization data such that analysis can be performed to understand and study element contributions, values and effects. While Bielinski teaches a number of values used in modeling, Bielinksi does not teach market sentiment. Baur teaches market sentiment in analysis. Incorporating multiple values into a model is old and well known, even where Bielinksi discloses the inclusion of multiple variables. Examiner therefore contends that functionality would remain by using the models across the systems. Likewise, examiner asserts that combinations with the other references relied upon in the Office Action would provide for functionality when combined. A full analysis of why the references would be combined and the combination obvious is provided above, with motivations for combination which would provide for predictable results.

Examiner further notes that the claims are examined on their merits based on the contents therein. For example, Appellant states that Lyons teaches a method for manipulating financial schedule information while the present application analyzes data that describe the physical operation of a business using a predefined process. While this language may generally address the teachings of Lyons and the present application, examiner notes that this language is not within the claims. A similar finding is made with respect to the arguments made regarding the Srivastava and Bauer

reference. Examiner contends that the claim language has been properly analyzed and

that the references as cited teach the claim language as presented.

Applicant argues that Examiner has failed to explain the rationale for combining

the teachings of the cited documents. However, in each instance of combination, the

reason for the combination has been provided in terms of which limitations are taught by

which reference, and a motivation for the combination has been provided. Examiner

believes that proper combinations have been made and proper motivations and

rationales set forth within the claim rejections. The courts have found that "A

suggestion, teaching, or motivation to combine the relevant prior art teachings does not

have to be found explicitly in the prior art, as the teaching, motivation, or suggestion

may be implicit from the prior art as a whole, rather than expressly stated in the

references... The test for an implicit showing is what the combined teachings,

knowledge of one of ordinary skill in the art, and the nature of the problem to be solved

as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217

F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot

be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of

obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This

requirement is as much rooted in the Administrative Procedure Act, which ensures due

process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45." In re

Kahn, 78 USPQ2d 1329, 1336 (CA FC 2006).   XXXXX   "It is, of course, not necessary

that either [prior art references] actually suggest, expressly or in so many words, the

changes or possible improvements appellant has made." In re Sheckler, 168 USPQ

716, 717 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the

references, the Courts have stated that "[a] suggestion, teaching, or motivation to

combine the relevant prior art teachings does not have to be found explicitly in the prior

art, as the teaching, motivation, or suggestion may be implicit from the prior art as a

whole, rather than expressly stated in the references...The test for an implicit showing is

what the combined teachings, knowledge of one of ordinary skill in the art, and the

nature of the problem to be solved as a whole would have suggested to those of

ordinary skill in the art... there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness." (emphasis added) In re

Kahn, 78 USPQ2d 1329, 1336 (CA FC 2006). Examiner asserts that "articulated

reasoning" to support the legal conclusion of obviousness has been made.

With regards to Applicants claim that the rejections fail under APA standards,

Examiner believes that the claims have been properly rejected. Examiner believes that

the rejections as set forth in the Office Actions have addressed each claim limitation

using prior art which addresses the claim limitations and that where any combinations of

prior art were used to reject claims that proper evidence and motivation for such a

combination has been provided. Therefore the Examiner asserts that both standards of

the APA have been followed and that the Office Action is proper with respect to the

evidence provided in rejecting the claims.

Appellant states that "the claimed invention comprises a surprising result. Market sentiment (as defined in the instant application) is relevant to organization management and value. This is a surprising result because the teachings of all the references provided by the Examiner, namely that markets are always efficient and that security prices are always accurate, have surprisingly been found to be incorrect". Examiner is unsure as to the nature of this argument. None of the references nor any statements made by the examiner speak to this concept of markets always being efficient and security prices always being accurate. Baur specifically discloses the consideration of market sentiment, and the other references do not disclose that the use of sentiment is a poor choice.

Likewise, Appellant has argued that examiner has failed to explain what would motivate someone to make the combinations as set forth above. However, examiner contends, again, the proper combinations and motivational statements have been provided. Evidence has been provided for the claim rejections, as provided above in the detailed mapping of each claim limitation, as well as with the motivation statements. Examiner contends that proper APA standards have been followed in all regards.

With regards to prior art arguments, examiner contends that the claims have been properly analyzed and rejected based on the prior art of record. Examiner contends that the level of detail in the claims has been properly considered, that the prior art has been properly mapped to the claim limitations, following all appropriate standards and procedures.

Appellant argues whether the examiner is skilled in the art stating "This apparent misrepresentation may be a product of the fact that the Examiner does not appear to have the requisite level of skill in the relevant arts…" Additional arguments are made as to whether the author of the Office Actions and persons signing the Office Actions are skilled and knowledgeable in the art. Examiner is unable to speak to this argument, but rather is focusing on addressing the claims and the rejections thereof as part of the Appeal Brief process. Hiring and training practices are outside the scope of examiner's expertise in addressing the claim limitations and arguments related thereto.

The 101 rejection is argued. Examiner has rejected the method claims under 101 based on the guidance available at the time based on the Supreme Court decision for Bielski and Langemyeret. As detailed above, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

This rejection has been argued on several grounds. As noted in the Final Office Action, in the present application, data is being received and stored in a database for processing. As such, there is no transformation of a subject matter (such as an article or materials). Likewise, it is claimed in the preamble that the data preparation method is computer implemented. However, the body of the claim fails to be tied to a particular machine carrying out the method steps. It is argued in the Appeal Brief that the examiner failed to explain how the claimed inventions can be completed using mental processes. However, examiner notes that a method claim that recites pure mental steps is only one example of a claim which would fail to meet the requirements of 101. The Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Therefore, a method which could be performed using only mental steps would be an example of a claim which would be rejected under 101, but that is merely one example. The primary tests is whether a § 101 process is (1) tied to a machine or (2) transforms underlying subject matter (such as an article or materials) to a different state or thing. As examiner understands the 101 guidelines, the argument as presented on page 69 of the Appeal Brief that claims "describe processes for transforming data representative of things that physically exist (i.e. a business, customers, vendors, etc.) into a different state or thing: a model of enterprise financial performance. As such that represent statutory subject matter." is not a correct interpretation of the 101 guidelines related to data transformation.

Additionally, Appellant has argued the relevance of several other allowances based on the current 101 guidelines. Examiner notes that only the current guidelines are applied when examining a set of claims and claims that were previously issued may have been subject to a different set of guidelines. Only current guidelines are implemented when performing claim analysis.

It is also suggested by Appellant that different standards for 101 requirements are applied to the prosecution of claims for large entities and small entities. Examiner notes that only one standard is used for all applications regardless of the size of the entity making the submission, be it for 101, 102, 103 or other requirements. A single set of standards exist.

With regards to the arguments set forth regarding 112 first paragraph, examiner contends that the 112 first paragraph rejections are proper. Examiner has noted the phrases "an integrated database", "output said database" and "a physical object or substance" as the phrases which are unsupported in the specification or initial disclosure. While it is not required that the exact and specific words be used in the specification as support for the language amended into a claim, the language is required to be supported by the specification. Examiner contends that the phrases above were amended into the claims, but that there is not support for the phrases. Support is founds in neither the use of specific and exact words, nor within provided or determined context from which the material can be obtained. In order to amend claims, the amendments must be supported by the initial disclosure be it in the drawings, specification or claims. However, upon presenting the amendments being discussed,

there was no indication as to where support for these elements could be found, and examiner was unable to find support for these elements and therefore the 112 rejections were made. Examiner contends that the 112 rejections for new matter are proper and maintains the rejections.

The 112 second paragraph rejections are also argued. The 112 rejections as set forth above detail the lack of clarity found in the language and the rejections stand. Examiner contends that the meets and bounds of the claims are unclear based on the reasoning and rationale as detailed above and that the claims are unclear as presented. In each instance, the examiner stated what would be assumed for purposes of examination. In each case, the Appeal Brief notes that the examiner was incorrect. Examiner finds that supports the examiner's position that the claims are unclear as a reasonable interpretation of the claim limitation meets and bounds could not be inferred from the claim limitations as presented. Examiner finds that the 112 second paragraph rejections are proper and appropriate.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jennifer Liversedge/

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